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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,082	03/19/2004	Benjamin Alan Askren	2002-0788.02/4670-167	7710

7590 08/17/2005

LEXMARK INTERNATIONAL, INC.
ATT: JOHN J. McARDLE, JR.
740 WEST NEW CIRCLE ROAD
LEXINGTON, KY 40550

EXAMINER

REIS, TRAVIS M

ART UNIT PAPER NUMBER

2859

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/805,082

Applicant(s)

ASKREN ET AL.

Examiner

Travis M. Reis

Art Unit

2859



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-20 is/are rejected.
- 7) ☒ Claim(s) 11 and 12 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Allowable Subject Matter

1. Prosecution on the merits of this application is reopened on claims 1-20 considered unpatentable for the reasons indicated below:
2. The indicated allowability of claims 1-20 is withdrawn in view of the newly discovered reference(s) to the article "HP Wins Lawsuit Over Half Full Cartridges" (Hereafter Prior Art). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
5. Claims 1-10, 14-16, & 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. (U.S. Patent 4766457) in view of the Prior Art.

With reference to claims 1-10, 14-16, & 18-20, Baker et al. discloses a method of manufacturing a plurality of toner cartridges, supplying a printer to a user and utilizing said printer, the method steps met through the normal operational usage of the printer (10) the method comprising the steps of prior to first using, forming a plurality of identical toner cartridge housings (27); dividing a chamber holding the toner into a first (29) and second section (X see below) by a wall (68), wherein the first section contains toner and the second section is free of toner(Figure 3); shipping the image forming device to the user with a first cartridge having a first maximum toner capacity and a first housing having a first external shape (65); forming images with the image forming device and using the toner from the first cartridge (Figure 1); supplying the user with a second maximum toner capacity and a second housing having a second external shape; and replacing the first cartridge with the second cartridge(col. 1 lines 46-52); the first external housing shape being substantially the same as the second external housing shape manufactured by a common mold and a common manufacturing process (Figures 2 & 3).

Baker et al. does not disclose the first maximum toner capacity being at most half the capacity and have a lesser weight than the second maximum toner capacity.

The Prior Art discloses that economy cartridges are shipped with printers containing half the ink of regular cartridges (para. 4, line 5). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to put half the capacity as taught by the Prior Art into the first cartridge disclosed by Baker et al. in order to remain competitive in the marketplace.

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6. Claims 13 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al. and the Prior Art as applied to claims 1-10, 14-16, & 18-20 above, and further in view of Kurosawa et al. (U.S. Patent 6226477).

Baker et al. & the Prior Art disclose all of the instant claimed invention as stated above in the rejection of claims 1-10, 14-16, & 18-20, but does not disclose the divider wall is rigid.

Kurosawa et al. discloses a toner cartridge (1) having separable parts (2, 3) kept apart by a rigid wall (indicated at 12). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to replace the divider wall in the first cartridge disclosed Baker et al. & the Prior Art with the rigid wall as taught by Kurasawa et al. in order to simplify assembly of the first cartridge by making the rollers (70) unnecessary.

Claim Objections

7. Claims 11 & 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or clearly suggest attaching a greater number of agitating members to the second toner cartridge than to the first toner cartridge, in combination with the remaining limitations in the claims.

Conclusion

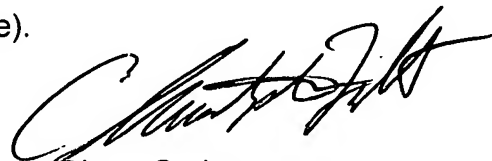
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis M. Reis whose telephone number is (571) 272-2249. The examiner can normally be reached on 8--5 M--F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Travis M Reis
Examiner
Art Unit 2859

tmr
August 15, 2005



Diego Gutierrez
Supervisory Patent Examiner
Tech Center 2800

CHRISTOPHER W. FULTON
PRIMARY EXAMINER